

## **REMARKS/ARGUMENTS**

### **Anticipation - Section 102(b) Rejection**

The Examining Attorney has rejected claims 1-7, 9-17, 19-24, and 26-28 as being anticipated by Van Sickle et al. (5,811,960). The Applicant respectfully requests the Examining Attorney reconsider the rejection based on the arguments set forth below, and because the examiner has not met the minimum required to make a prima facie case for anticipation.

The applicant submits that Van Sickle et al. does not anticipate this invention for the following reasons:

1. Van Sickle et al. does not disclose the purpose, means or mechanism that this invention discloses as it does not have an integrated system, but instead is a system in multiple cabinets. For instance global bypass cabinet 200 contains some elements such as the breakers 223 and 222, whereas the automatic transfer switch 229 is contained separately, as is the backup generator 280.

Furthermore, Van Sickle does not include a transient voltage surge suppression device, but instead merely has a system disconnect (as is also separately designated in this application).

There is no anticipation where a reference does not disclose the purpose, means and mechanism for accomplishing the instant invention but rather is

restricted to a limited and different means. Sperry Products, Inc. V. Aluminum Company of America, 120 U.S.P.Q. 362.

2. Van Sickle et al. does not solve the problems this invention solves, for the reasons set forth in number 1 above.

There is no anticipation if a prior patent does not solve the problem(s) which the subsequent patent successfully solves. Technical Development Corporation v. Servo Corporation of America, 125 U.S.P.Q. 133.

3. Van Sickle et al. does not disclose each and every element of this invention, as set forth above in number 1. For instance, Van Sickle does not disclose a transient voltage surge suppression device, or an integrated system on one framework.

There is no anticipation if the reference does not disclose each and every element of the claimed invention. SSIH Equipment S.A. v. United States International Trade Commission, 718 F.2d 365, 218 U.S.P.Q. 678 (1983).

Since each independent claim in the application includes or requires each of the elements referred to above, the arguments apply to all such independent claims, as well as to all claims which are dependent thereon.

### **Obviousness - Section 103(a) Rejection**

The Applicant submits that the subject matter of the various claims was commonly owned at the time any inventions covered herein were made, as reflected in the assignment records.

The examiner asserts that claims 8, 18 and 25, are obvious under section 103(a), based on Van Sickle et al. (5,811,960) in view of Bower et al. (5,646,458). Applicant requests the Examiner reconsider the rejection for the reasons set forth above with respect to obviousness since the combination of the two references do not comprise all of the elements of the claims in question.

Even assuming for purposes of argument that the two references contained all the elements, there is nothing in either of the references which teaches or suggests making the combination, or which suggest the desirability of the combination, and therefore the Examiner has not met the minimum required showing for *prima facie* obviousness.

In the U.S. Court of Appeals for the Federal Circuit case of *In Re: Lee*, 61 U.S.P.Q. 2d 1430, decided January 18, 2002, the Federal Circuit held:

... Thus, when they rely on what they assert to be general knowledge to negate patentability, that knowledge must be articulated and placed on the record. The failure to do so is not consistent with either effective administrative procedure or effective judicial review. The Board cannot rely on conclusory statements when dealing with particular combinations of prior art and specific claims, but must set forth the rationale on which it relies.

The examining attorney has therefore failed to meet the requirement to set forth with specificity the general knowledge in the art to enable a finding that the person having ordinary skill in the art would make such combination.

As the PTO recognizes in MPEP 2142:

The legal concept of *prima facie* obviousness is a procedural tool of examination which applies broadly to all arts. It allocates who has the burden of going forward with production of evidence in each step of the examination process.... The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the Examiner does not produce a *prima facie* case, the Applicant is under no obligation to submit evidence of non-obviousness.... The initial evaluation of *prima facie* obviousness thus relieves both the Examiner and Applicant from evaluating evidence beyond the prior art and the evidence in the specification as filed until the art has been shown to suggest the claimed invention.

MPEP 2143.01 provides:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re: Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

The Federal Circuit has several times expressly addressed the issue of how to evaluate an alleged case of *prima facie* obviousness to determine

whether it has been properly made. Thus, *In re: Geiger* stated in holding that the PTO "failed to establish a *prima facie* case of obviousness:


Obviousness cannot be established by combining the teaching of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. *ADC Hospital Systems, Inc. V. Monteffiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984).

### Conclusion

Applicant therefore submits Claims 1-28 are in a position to proceed to allowance.

Respectfully submitted,

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